

## REMARKS

### Claim Status

Claims 1-11 are pending in the present application. No additional claims fee is believed to be due.

### Rejection Under 35 U.S.C. §103(a) Over Schleinz et al. In View Of Burazin et al.

Claims 1, 3, 4, 7, 10 and 11 stand rejected under 35 U.S.C. §103(a) over Schleinz et al. (U.S. Pat. No. 5,458,590) in view of Costolow (U.S. Pat. No. 3,972,854). Applicants respectfully request reconsideration.

Applicants respectfully submit, first, that the references do not disclose all elements of Applicants' claims; and second, that a showing of a teaching, suggestion or motivation to combine the cited references and modify the teachings of Schleinz et al. in a manner that arrives at Applicants' claims, has not been shown.

As discussed below, Applicants believe that independent Claim 1 is patentable over the prior art references most recently cited. If Claim 1 is patentable, it follows that the remaining claims, being dependent and narrower in scope, are patentable as well.

Therefore, without waiving any arguments they may otherwise have, Applicants defer arguments concerning rejection of Claims 2, 5, 6, 8 and 9 over Schleinz et al. in view of Costolow and further in view of: McCormack et. al. (U.S. Pat. No. 6,719,742) (Claims 2, 5 and 6 - Office Action at ¶33); and McFarland et al. (U.S. Pat. No. 6,096,412) (Claims 8 and 9 - Office Action at ¶38).

#### A. Requirements for *Prima Facie* Case of Obviousness

##### *1. Claimed Invention As A Whole Must Be Considered.*

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between the cited art

and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q. 871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the Applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

2. *All Claim Elements Must Be Taught Or Suggested By Prior Art.*

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

3. *A Teaching, Motivation or Suggestion to Combine the Cited References Must be Found in the Prior Art.*

[A] patent [claim] composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

*KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007).

Accordingly,

a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis . . . . *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention."). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence—teachings, suggestions (a telling broad term), or motivations (an equally broad term)—that arise

before the time of invention as the statute requires. As KSR requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

*Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364-1365; 86 U.S.P.Q.2D 1196 (Fed. Cir. 2008) (judgment of nonobviousness and infringement affirmed). The lack of evidence of a motivation to combine is a critical defect in an obviousness conclusion, because there must be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336; 69 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 2004).

However,

... [t]here is no suggestion to combine [references] ... if a reference teaches away from its combination with another source. *See id.* at 1075, 5 U.S.P.Q.2D (BNA) at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Sponnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

*Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1359-1360; 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*,

796 F.2d 443, 448, 230 U.S.P.Q. 416 (Fed. Cir. 1986), *quoting In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

B. Analysis

I. *The Combination of Cited References Does Not Teach or Suggest All Elements of Applicants' Claims.*

Current Independent Claim 1 recites a disposable article selected from baby diapers, pull-on diapers, pants or adult incontinence diapers comprising, *inter alia*, a backsheet that comprises at least one polymeric film and at least one nonwoven web formed of fibers, wherein said polymeric film and said nonwoven web each have two major surfaces, said polymeric film comprises a polymeric film material, and said nonwoven web fibers comprise a polymeric nonwoven web material, wherein at least one of said polymeric film material or said polymeric nonwoven web material is color-pigmented by one or more pigments mixed therinto prior to formation of said polymeric film or said nonwoven web, and wherein at least one of said polymeric film or said nonwoven web has visually discernible printed designs, said printed designs being provided by printing a pigmented ink onto at least one of said major surfaces of at least one of said polymeric film or said nonwoven web, and said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet, and wherein said backsheet in said overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an "a" value for red/green-appearance from about -50.0 to about +50.0 and a "b" value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed designs. By dependency, each of the remaining claims includes all of these elements.

Without waiving any other arguments they may have, Applicants submit that Schleinz et al. and Costolow, neither alone nor in combination, teach or suggest a composite backsheet (*i.e.*, combination of polymer film and nonwoven) having printed designs, with an L Hunter

value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an “a” value for red/green-appearance from about -50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed designs.

Schleinz et al. addresses inks and the crockfastness of inks after printing. It is silent concerning the coloration (expressed in L Hunter value) of a substrate upon which printing is done, in areas outside the printing.

Costolow teaches a method for color control and stabilization of fiber-grade polypropylene, involving admixing various agents to polypropylene homopolymer under process conditions that regulate the presence of oxygen in the mixing atmosphere. (See Costolow at Col. 1, lines 36-50.) As best understood by Applicants, Costolow does not teach tinting or pigmentation of the polypropylene to arrive at an end product falling within particular color/lightness ranges. Rather, it appears that Costolow only teaches monitoring and striving to achieve particular Hunter values in the pellet product of the described process as an indication that oxygen present in the mixing process is being properly regulated (Costolow at Col. 4, lines 20-33), and to assure that the process results in a product “generally preferred for use in [subsequently] producing dyed or pigmented fiber products while maintaining lightness (L) essentially constant.” (Costolow at Col. 5, lines 22-24.)

Importantly, Costolow teaches, not a combination backsheet, not a nonwoven web component of a backsheet, and not even a nonwoven web, having particular Hunter color/lightness values, but rather, only polypropylene *pellets* having particular Hunter values. (Costolow at Fig. 1 (lower right); Col. 1, line 67 – Col. 2, line 5 (“pelleted fiber-grade polypropylene compositions”.) Costolow neither teaches, nor contains any mention or even suggestion of forming a nonwoven web or backsheet having these values.

For this reason, Applicants respectfully submit that the combination of Schleinz et al. and Costolow does not teach or suggest all elements of Applicants’ claims, and therefore, does not support a *prima facie* conclusion of obviousness of the claims.

2. *A Teaching, Motivation or Suggestion for the Combination of the Cited References in a Manner That Arrives at Applicants' Claims Has Not Been Established.*

Schleinz et al. addresses the problem of crockfastness of printing of products such as diapers. There is no mention in Schleinz of a problem of translucency or to look for ways to address a problem of translucency – and thus, no teaching, motivation or suggestion to consult other art, within the scope of materials used for diapers or outside that scope – to address translucency.

Costolow addresses a problem of producing a pelletized polypropylene raw material that is color-stable and “generally preferred for use in [subsequently] producing dyed or pigmented fiber products while maintaining lightness (L) essentially constant.” (Costolow at Col. 5, lines 22-24.)

The Office states:

... Schleinz calls for printing with bright colors (col. 6, lines 40-44). Polypropylene having the  $L^*a^*b^*$  values within the ranges of Costolow provides a bright background for these images. Therefore, it would have been obvious to one of ordinary skill in the art . . . to modify the invention of [Schleinz] as discussed with the fiber-grade polypropylene of Costolow in order to provide a bright background for printing images as called for by Schleinz.

(Office Action at p. 6.)

Applicants respectfully submit that the foregoing does not identify a prior art teaching, motivation or suggestion to combine Costolow with Schleinz, whereby the backsheet of Schleinz is modified such that it would fall within Applicants' claims.

First, there is no evidentiary support for the Office's assertion that “[p]olypropylene having the  $L^*a^*b^*$  values within the ranges of Costolow provides a bright background for

[Schleinz's] images," nor for the premise that Schleinz calls for a "bright background" for printing.

Second, elsewhere within prior art previously cited by the Office in this prosecution, it is suggested that a backsheet for an article of the type of Applicants' claims (*e.g.*, diapers) having colors, outside printed areas, falling within the ranges of Applicants' claims, *would be undesirable*. (See PTC Application No. WO 99/32164 (by Tao et al.), at page 2, lines 23-26 ("a high degree of whiteness, *i.e.*, the visual appearance of the white color of the article as seen by the consumer, is very important to the consumer".) Thus, evidence of record teaches away from Applicants' claimed invention, and no evidence of record teaches, suggests or motivates a combination of Costolow with Schleinz et al., and modification of Schleinz et al., in a manner that would bring it within the scope of Applicants' claims.

In summary, Schleinz et al. contains no suggestion of a combination with other art to address a problem of translucency; Costolow contains no suggestion of a problem of translucency in articles such as diapers, or that the technology it discloses has applicability to the technology of Schleinz; and elsewhere in the prior art it is suggested that coloring a diaper backsheet (outside printed regions) to the Hunter L values of Applicants' claims would be undesirable.

For these reasons, Applicants respectfully submit that a teaching, motivation or suggestion of a combination of Schleinz et al. and Costolow has not been established.

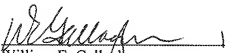
Appl. No. 10/730,438  
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Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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